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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,773	02/05/2002	Akira Shibata	SHO 1008-01US	7568
28327	7590	07/13/2004	EXAMINER	
THE LAW OFFICE OF JOHN A. GRIECCI 703 PIER AVE., SUITE B #657 HERMOSA BEACH, CA 90254			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/068,773	Applicant(s) SHIBATA ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/10/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicants' Information Disclosure Sheet (IDS), amendments and remarks filed on 5/10/2004. Applicants' amendments to claims 1 and 17 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, in view of the newly amended claim 1, which changes "augmenting" to "adding to", and also the provided support in the specification on page 15, lines 3-16, the prior rejection of claims 1-3 under 35 U.S.C. 112, second paragraph is withdrawn. Similarly, the newly provided support in the specification at page 8, lines 1-4, and page 15, lines 3-16 are sufficient to overcome the prior rejection of claim 21 under 35 U.S.C. 112, first paragraph.

Information Disclosure Statement

4. Since the newly submitted IDS references are also found to render obvious the instant claimed invention, new grounds of rejection has been made.

Additionally, it is noted that only page 1 (claims) of the English translation of JP Hei 3-85886 is submitted with the IDS filed 5/10/2004. Applicants are requested to provide a full copy of the translation in the next communication, if it is available, because the reference appears to contain further details which may be pertinent prior art.

Drawings

5. Because Fig. 11(A) shows a tray mat according to a conventional technique (specification, paragraph 0085), it should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. Claims 1-3 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, the term "configured" appears to be deliberately vague and indefinite, because it imparts no structural definition yet implies something is done. Also at line 8, the phrase "adding to ..." is vague and indefinite, because it provides no means by which the function is expected to be accomplished.

Similarly, in claim 3, line 3, the phrase "configured as a tray mat to be" appears to be deliberately vague and indefinite in its scope. The Examiner suggests structural clarification or deletion, as it appears unnecessary.

In claim 12, line 2, the recitation misses words from its original claim, please correct the recitation "in contact with the ," as --in contact with the absorption sheet,--.

Claim Rejections - 35 USC § 103

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 3-85886 (English translation) in view of JP 2000025869 (Derwent Abstract), and further in view of JP 9-86569 (English translation).

JP '886 is directed to a liquid absorption sheet for food, which is a laminate of an absorption sheet layer and a porous plastic sheet which has numerous three-dimensional apertures (holes) to guide drips oozing from the food to the absorption sheet (page 1, lines 7-11). The absorption sheet contains a freshness preservative for maintaining the freshness of the food (page 1, lines 23-25).

For claim 1, JP '886 lacks an express teaching that the absorption sheet is breathable both in the horizontal and the thickness directions, and the amount of ventilation resistance in the thickness direction. However, it is noted that the invention of JP '869 is also directed to a food tray mat, and JP '869 teaches that the freshness of fish is maintained for a long time by an absorbent tray mat with holes which is air permeable (breathable, which measurable by ventilation resistance). As such, it would have been obvious to one of ordinary skill in the art to modify the apertures (holes) of JP

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'886, so as to provide a suitable air permeability (breathability, or ventilation resistance), motivated by the desire to obtain an improved absorption sheet which maintains the color and freshness in food for a long time. As to the breathability in both directions and the ventilation in the thickness direction, in the absence of unexpected results, since the claim lacks any structural definition for "configured", these aforementioned elements are believed to be integral components of the overall air permeability, and are either anticipated, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to maintain the freshness of the food. It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. Finally, the Examiner notes that no physical features are present in claim 1 so as to exclude the applied art from the scope thereof, and "adding breathability" is relative terminology that is neither qualified or quantified. Thus holes in the prior art devices serve to meet the broad and vague claim limitations.

For claims 2 and 6, JP '886 lacks an express teaching that the absorption sheet comprises a non-woven fabric, and its thickness. However, it is noted that JP '569 is directed to a food drip tray mat, and JP '886 expressly teaches that the non-woven fabric is used as absorbent material (Abstract). As such, it would have been obvious to one ordinary skill in the art to select a non-woven fabric as the absorption sheet of JP '886. The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. As to the

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thickness of non-woven fabric, in the absence of unexpected results, it is believed to be either anticipated, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain required absorbency.

For claims 3 and 7, although JP '886 does not expressly teach that the laminated absorption sheet is used as a tray mat, it is noted that Applicants have expressly admitted that JP '886 is used as a food drip tray mat (specification, page 1, bottom paragraph).

For claims 4, 5, 9 and 10, although JP '869 lacks an express teaching of the ventilation resistance (or breathability) in the thickness direction, the Examiner repeats that since JP '869 teaches that the freshness of fish is maintained for a long time by an absorbent tray mat with holes which is air permeable (breathable), it would have been obvious to one of ordinary skill in the art to modify the apertures (holes) of JP '886, as taught by JP '869, so as to provide a suitable air permeability (breathability), motivated by the desire to obtain an improved absorption sheet which maintains the color and freshness in food for a long time.

For claim 8, regarding the recitation of the ventilation resistance testing method, the Examiner notes that while the testing method measures a property of the drip absorption mat, the method itself clearly is not a structural element of the instant invention, and bears no weight in patentability.

For claims 11, 20 and 21, JP '886 translation teaches that "the apparent thickness of said porous plastic sheet including the three-dimensional apertures is four times or more the thickness of said plastic sheet itself" (page 1, lines 14-16). As such,

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in the absence of evidence to the contrary, it is the Examiner's position that JP '886 implicitly teaches a hollow cavity under the surface of the convex portion of the surface sheet, because JP '886 expressly teaches that the apparent thickness of the configured porous plastic sheet is four times or more than the thickness of the plastic sheet itself.

For claims 12 and 14-16, JP '886 lacks an express teaching that the terminal portion of the porous surface sheet is in contact with the absorption sheet, and is notched. However, it is noted that JP '569 teaches that the porous surface sheet is thermally bonded to the nonwoven layer via various bonding patterns, such as dots and lines (Figs. 2-7), and the edge is preferably not bonded (paragraph 0013), which structurally reads on a notched (open) edge. As such, it would have been obvious to one of ordinary skill in the art to modify JP '886 with the aforementioned elements taught by JP '569, motivated by the desire to obtain a bonded (laminated) tray mat having sufficient drip passages. Regarding the various functional limitations, such as "facilitate air flow" and "not clog said minute aperture", etc., the Examiner repeats that a suitable low ventilation resistance in horizontal direction is believed to be an integral component of the overall air permeability of the food tray mat, as set forth above.

Further, since JP '569 teaches essentially the same subject matter (food drip mat), it is believed that bonding the layers together while not clogging the aperture is also either anticipated, or obvious optimization to one skilled in the art of laminated drip mat, motivated by the desire to maintain a good drainage. Finally, it is the Examiner's position that these functional limitations may, in fact, be inherent characteristics of the prior art, Applicants may wish to submit a proper Declaration to prove that the subject

matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 @ 229 (CCPA 1971).

For claim 13, JP '569 teaches that it is desirable to form the passage to the gauze (nonwoven) front face which narrows down at the base, so as to function as a check valve to prevent back flow (paragraph 0007).

For claims 17 and 18, it is noted that the admitted prior art Hei '886, or Hei '569, is silent about the total space occupied by the film and the number of apertures in the absence of unexpected results. However, since the admitted prior art Hei '886, or Hei '569, teach essentially the same subject matter (food drip mat), in the absence of unexpected results, it is believed that the aforementioned elements are either anticipated by the teachings of the admitted prior art Hei '886 and/or Hei '569, or obvious optimizations to one skilled in the art of food drip mat, motivated by the desire to reduce the cost of the material, and to obtain a sufficient drip flow rate.

Lastly, for claim 19, as set forth above for claim 8, the Examiner repeats that while the testing method measures a property of the drip absorption mat, the method itself clearly is not a structural element of the instant invention, and bears no weight in patentability.

8. Claims 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art in view of O'Connor et al. (US 2003/0108646 A1), substantially for the reasons set forth in section 9 of Office action mailed 1/7/2004, together with the following additional observations.

Applicants' argument that the filing date (2/5/2001) of Japanese priority document JP 2001-028776 outdates the filing date (12/12/2001) of US 2003/0108646 A1 has been considered. However, since Applicants fail to provide a certified translation of the foreign priority document, the O'Connor et al. reference is still deemed to be proper, and the rejection is maintained. See 35 USC 119(B)(3), 37 CFR 1.55 (4), and MPEP 201.15.

Response to Amendment

9. Applicants' argument that "The art referred to in the application, as cited in the Office Action, fails to describe, teach or suggest a surface sheet configured to add to the breathability of an absorption sheet in the horizontal and thickness directions. It also fails to describe, teach or suggest the low ventilation-resistance (i.e., highly breathable) drip absorption mat of the current application" (Remarks, page 9, last full paragraph) has been carefully considered, but is not persuasive. The Examiner repeats that it would have been obvious to one of ordinary skill in the art to modify the holes of Hei '886, or Hei '569, to provide a suitable amount of air permeability, as taught by JP '869, motivated by the desire to prevent changes in meat color and freshness, as set forth above.

With respect to Applicants' argument that the apertures of the prior tray mats "are not configured to add to the breathability of the absorption mat, such as by supporting a hollow cavity, and are not configured to provide a low level of ventilation resistance in the thickness direction." (Remarks, page 10, top paragraph), the Examiner repeats (see

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page 4 of Office action mailed 01/07/2004) that "supporting a hollow cavity" is absent from claims 1-10 and the claims in general lack any structural definition for "configured", as set for above. Further, since the prior art teaches essentially the same subject matter, configuring the tray mat to support a hollow cavity is also believed to be either anticipated, or an obvious optimization to one of ordinary skill in the art of a breathable tray mat, motivated by the desire to maintain an open cavity for improved air permeability, so as to prevent changes in food color and freshness.

With respect to Applicants' repeated arguments "the applicant increased the breathability of the absorption mat, not only in thickness direction but also in the horizontal direction." (Remarks, page 10, lines 10-11) and "knowing an air-permeable sheet is desirable ... does not inherently suggest that a surface sheet should be configured to add to breathability to an absorption sheet in both the horizontal and thickness directions." (Remarks, page 10, lines 24-27), the Examiner repeats that while the prior known is silent about the amount of air permeability in each specific direction, in the absence of evidence to the contrary, a suitable low ventilation resistance in horizontal direction is believed to be an integral component of the overall air permeability of the food tray mat, as taught by JP '869, as set forth above. Finally, it is noted that there is no physical features are present in the instant claims so as to exclude the applied art from the scope thereof.

10. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 5/10/2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS**

MADE FINAL. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor S Chang
Examiner
Art Unit 1771

6/28/2004



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700